

**REMARKS**

This communication is a full and timely response to the Office Action dated December 2, 2004 (Paper No./Mail Date 20041129), and in particular to the non-final Office Action dated July 1, 2004 (Paper No./Mail Date 12). By this communication, claims 1, 2, 9, 10, and 29 have been amended.

Each of independent claims 1, 2, 9, 10, and 29 have been amended to recite the diffraction element includes a pair of opposite surfaces and a diffraction grating is disposed on a lower surface of the pair of opposite surfaces. Support for the subject matter added to claims 1, 2, 9, 10, and 29 can be found variously throughout the specification and drawings, for example, at paragraph [0080] of the instant application (U.S. Patent Application Publication No. 20010021163) and Fig. 9 of the drawings. No new matter has been added.

Claims 1, 2, 9, 10, and 17-29 are pending where claims 1, 2, 9, 10, and 29 are independent.

**Non-Responsive Amendment**

The Office Action dated December 2, 2004 (Paper No./Mail Date 20041129) alleges that the Amendment filed by Applicant on August 12, 2004 was non-responsive. Applicant disagrees. However, in an effort to expedite prosecution by this communication Applicant has amended claims 1, 2, 9, 10, and 29 to address these allegations. Accordingly, Applicant respectfully submits that the current amendment is fully responsive to the non-final Office Action dated July 1, 2004 (Paper No./Mail Date 12).

**Rejections Under 35 U.S.C. §102**

Claims 1, 2, 9, 10, 17, 18, 20, 21, 23, 24, 26, 27, and 29 were rejected under 35 U.S.C. §102(e) as anticipated by *Uchizaki et al.*, U.S. Patent No. 6,646,975. Applicant respectfully traverses this rejection.

Independent claim 1 recites an optical pickup device comprising a first light source for emitting a first light beam having a first wavelength; a second light source for emitting a second light beam having a second wavelength different from the first wavelength; an objective lens for focusing said first light beam or said second light beam to the signal recording surface of an optical recording medium of a first type matching to the first wavelength or that of an optical recording medium of a second type matching to the second wavelength, whichever appropriate;

a photodetector for detecting the light beam focused on the signal recording surface of the optical recording medium of the first type or that of the optical recording medium of the second type, whichever appropriate, by the objective lens and reflected by the signal recording surface; a diffraction element arranged in the light path from the light sources to the photodetector by way of one of the first or second type of optical recording medium, the diffraction element having a first diffraction angle and a second diffraction angle, wherein a difference between the first diffraction angle and the second diffraction angle is predetermined to offset a distance separating the first light source and the second light source; and at least one of the first light beam adapted to be used for reading information signals from the signal recording surface of the optical recording medium of the first type and reflected by the reflecting surface, or the second light beam adapted to be used for reading information signals from the signal recording surface of the optical recording medium of the second type and reflected by the reflecting surface being diffracted by the diffraction element, wherein the first diffraction angle diffracts the first reflected light beam and the second diffraction angle diffracts the second reflected light beam so that the first reflected light beam and the second reflected light beam being focused to a same spot on the light receiving surface of the photodetector, wherein the diffraction element includes a pair of opposite surfaces and a diffraction grating is disposed on a lower surface of the pair of opposite surfaces.

Similarly, each of independent claims 2, 9, 10, and 29 recites, among other things, the diffraction element includes a pair of opposite surfaces and a diffraction grating is disposed on a lower surface of the pair of opposite surfaces.

*Uchizaki* discloses an optical system having two laser light sources enclosed in a single integrated unit 11 that emit light having 650 nm and 780 nm, respectively. These beams travel through an optical path having a collimator lens 14, a re-orienting mirror 15, a wavelength selecting filter 16, an objective lens 17, a recording medium (DVD, CD, CD-R), and a photodetector PD35. This system may also include a holographic element 33 disposed strategically in the optical path. The holographic element 33 diffracts the light, which is emitted from either of the two light sources (RL1 and RL2) and reflected from the recording medium, such that the two diffracted beams (DL1P and DL2P) are converged on the same position of the photodetector PD 35. As shown in Figures 3A and 3B, the holographic element 33 has a diffraction grating on only one surface, and in particular the top surface of the holographic element 33. In contrast, each of claims 1, 2, 9, 10, and 29 recite the diffraction element includes

a pair of opposite surfaces and a diffraction grating is disposed on a lower surface of the pair of opposite surfaces. Accordingly, claims 1, 2, 9, 10, and 29 are not anticipated by *Uchizaki*.

To properly anticipate a claim, the document must disclose, explicitly or implicitly, each and every feature recited in the claim. See *Verdegall Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *Uchizaki* fails to teach each and every feature recited in the claims. Thus, claims 1, 2, 9, 10, and 29 are not anticipated by *Uchizaki*.

Accordingly, Applicant respectfully requests that the rejection of independent claims 1, 2, 9, 10, and 29 be withdrawn and these claims be allowed.

Claims 17 and 18 depend from claim 1, claims 20 and 21 depend from claim 2, claims 23 and 24 depend from claim 9, and claims 26 and 27 depend from claim 10. By virtue of this dependency, Applicant submits that claims 17, 18, 20, 21, 23, 24, 26, and 27 are allowable for at least the same reasons given above with respect to independent claims 1, 2, 9 and 10, where applicable. In addition, Applicant submits that claims 17, 18, 20, 21, 23, 24, 26, and 27 are further distinguished over *Uchizaki* by the additional elements recited therein, and particularly with respect to each claimed combination. Applicant respectfully requests, therefore, that the rejection of claims 17, 18, 20, 21, 23, 24, 26, and 27 under 35 U.S.C. §102 be withdrawn, and these claims be allowed.

#### **Rejections Under 35 U.S.C. §103**

Claims 19, 22, 25, and 28 were rejected under 35 U.S.C. §103(a) as unpatentable over *Uchizaki* in view of *Oohchida*, U.S. Patent 6,584,060. Applicant respectfully traverses this rejection.

Claim 19 depends from claim 1, claim 22 depends from claim 2, claim 25 depends from claim 9, and claim 28 depends from claim 10. By virtue of this dependency, Applicant submits that claims 19, 22, 25, and 28 are allowable for at least the same reasons given above with respect to claims 1, 2, 9, and 10, where applicable. In addition, Applicant submits that claims 19, 22, 25, and 28 are further distinguished over *Uchizaki* and *Oohchida* by the additional elements recited therein, and particularly with respect to each claimed combination. Applicant respectfully requests, therefore, that the rejection of claims 19, 22, 25, and 28 under 35 U.S.C. §103 be withdrawn, and these claims be allowed.

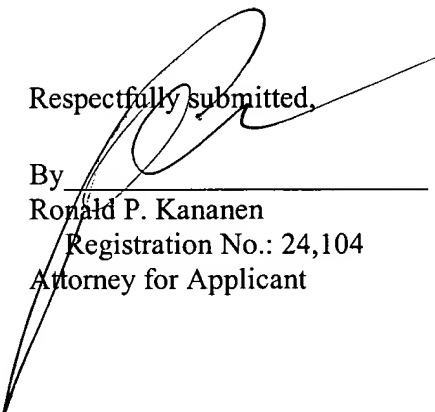
**Conclusion**

Based on at least the foregoing amendments and remarks, Applicants submit that claims 1, 2, 9, 10, and 17-29 are allowable, and this application is in condition for allowance. Accordingly, Applicants request favorable reexamination and reconsideration of the application. In the event the Examiner has any comments or suggestions for placing the application in even better form, Applicants request that the Examiner contact the undersigned attorney at the number listed below.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SON-2045 from which the undersigned is authorized to draw.

Dated: December 22, 2004

Respectfully submitted,

By   
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